

REMARKS

A. Status of the Claims

Claims 1, 2, 5, 6, 9-18, 20-25 and 28-34 were examined. In order to expedite prosecution, claims 16-18, 20-25 and 30-31 have been canceled without prejudice to reintroducing them at a later time or in a continuing application. Claims 1 and 28 have been amended for the reasons explained below. Claim 34 has been canceled because it is identical to amended claim 1. Thus, claims 1, 2, 5, 6, 9-15, 28, 29, 32 and 33 will be pending upon entry of the requested amendments.

B. The Pending Claims Are Patentable over References C2-C13

The Office rejects claims 1, 2, 5, 6, 9-18, 20-25 and 28-34 under 35 U.S.C. § 102(b) or, in the alternative, 35 U.S.C. § 103(a) over references C2-C13 as “being on public use [sic] and/or sale in this country by the applicants more than one year prior to the date of application for patent.” Action at page 2. Applicants traverse with respect to the claims that remain pending.

The Office states that the “[i]nstant claims are directed towards a device as shown in the references C2-C13 as admitted by the applicant in the IDS of 2/17/04 as on sale or public use more than one year before the filing date of the application.” Action at page 2. This is not correct. It is important to understand the differences between these references.

1. The Differences Between the References

a. C2

Reference C2 is a Lemna brochure that, as explained in the February 4, 2004 Information Disclosure Statement (IDS), “was published and made available to the public more than one year prior to the filing of this application, November 2, 2001.” Reference C2 also was published and

made available to the public more than one year prior to the filing date of October 5, 2001 of the parent application to this application. *See* Second Declaration of Michael Morgan at ¶ 2.

b. C3

Reference C3 is entitled “ON-FARM BIOGAS PRODUCTION” and has a copyright date on its second page of 1984.

c. C4

Reference C4 is a picture of a system that the February 4, 2004 IDS explains “was in public use more than one year prior to the filing date of this application, November 2, 2001.” Moreover, the system depicted in C4 was in public use (in this country) more than one year prior to the filing date of October 5, 2001 of the parent application to this application. Second Morgan Decl. at ¶ 5.

d. C5-C13

References C5-C13 all pertain to the same device shown to 8 Lemna Corporation employees on October 5, 2000, as explained in the IDS.

2. The Pending Claims Are Patentable over Reference C2

Now that the distinctions between these references is clear, Applicants address the Office’s arguments about patentability.

The Office states that “[t]he only element of the claims not clearly seen in these references is the service openings of claims 14, 15 and 24-27, which is shown by drawing 1-5, “Access Hatch” in reference C1, which is a proposal dated Nov , 1984, to build a membrane cover according to the specification provided by the solicitor (purchaser), and which belongs to a company by name ADI.” Action at page 2. This statement is incorrect for the following reasons.

a. Claim 1

Examined claim 1 was patentable over reference C2. Examined claim 1 recited a plurality of gas-relief passageways positioned either (a) within the claimed first float compartment membrane or (b) within the first membrane and adjacent to the first flotation member. This claim also recited that at least one of the gas-relief passageways within the first plurality is structured so that gas flows unobstructed through it **when the system is used**.

Reference C2 fails to disclose or suggest a gas relief passageway that is structured so that gas flows unobstructed through it when the C2 system is used. The second page of reference C2 shows the different insulation cover modules being connected with fastening devices that extend through openings in the modules (this is also shown in the cross-sectional view shown in page 4 of reference C2). However, the openings in which those fastening devices are positioned during use of the C2 cover system are obstructed with those fastening devices during use of the C2 cover system. Thus, they do not meet the claim limitation. Applicants specifically explained this in the current application:

As used in this document, including the claims, a gas-relief passageway that is structured so that gas flows unobstructed through it when the cover or covering system of which it is a part is used means that the passageway is designed and created to be used without a fastener or other obstructing device within it. **In addition to flowing through the gas-relief passageways, gas may also flow through the openings through which fasteners 12 are placed. This flow would not be unobstructed, however.**

Page 12, lines 13-18 (emphasis added); *see also* FIG. 1. Thus, examined claim 1 is novel and nonobvious over C2.

Nevertheless, claim 1 has been amended to match claim 34 (which has now been canceled) in order to expedite prosecution. As a result, amended claim 1 and its dependent claims are patentable over reference C2 for exactly the same reason given above: reference C2

fails to disclose or suggest a gas-relief passageway extending through a membrane from one side to the other that is structured so that gas flows unobstructed through it when the C2 system is used. The Office's service opening arguments about claims 14 and 15—even if accepted as true—do not cure the deficiency of reference C2.

b. Claim 28

Examined claim 28 is patentable over reference C2 because the reference does not disclose elevating at least a portion of a first membrane so that gas is directly vented to atmosphere through at least one gas-relief passageway positioned within one of the claimed membranes. The openings through which the fastening devices are threaded are obstructed by those fastening devices during use of the C2 cover system, and the gaps between the cover modules and not gas-relief passageways “within” a membrane.

Nevertheless, claim 28 has also been amended to match the relevant aspects of claim 34 in order to expedite prosecution. Claim 28 and its dependent claim remain patentable over reference C2 for the same reason: C2 does not disclose elevating at least a portion of the claimed first membrane so that gas is directly vented to atmosphere through at least one gas-relief passageway positioned within (and extending through) one of the claimed membranes.

c. Claim 32

Claim 32 recites, in relevant part, placing a covering system over a body containing some liquid, the covering system comprising a first membrane having an outer edge and a width, and a first flotation member coupled to the first membrane, the first flotation member including a first float having a width that is not more than twenty-five percent of the width of the first membrane. Reference C2 fails to disclose or suggest such a float. Accordingly, claim 32 and its dependent claim are patentable over reference C2.

3. The Pending Claims Are Patentable over Reference C3

The Office has not explained where in C3 the subject matter of either of the independent claims discussed above appears. More is needed to establish a proper rejection of claims 1, 2, 5, 6, 9-15, 28, 29, 32 and 33. *See* 37 C.F.R. § 104(c)(2); *see also* M.P.E.P. § 707.07(d) (“Where a claim is refused for any reason relating to the merits thereof it should be ‘rejected’ and the ground of rejection **fully and clearly stated** A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.”) (emphasis added).

Moreover, Applicants cannot find a cover system in reference C3 that meets all the limitations of any of independent claims 1, 28 or 32. For example, the limitations identified above with respect to the patentability of these independent claims over reference C2 are also neither disclosed nor suggested by reference C3.

4. The Pending Claims Are Patentable over Reference C4

a. Claims 1 and 28

Reference C4 fails to disclose or suggest the claimed gas-relief passageways of claim 1. For this reason, claim 1 and its dependent claims are novel over reference C4.

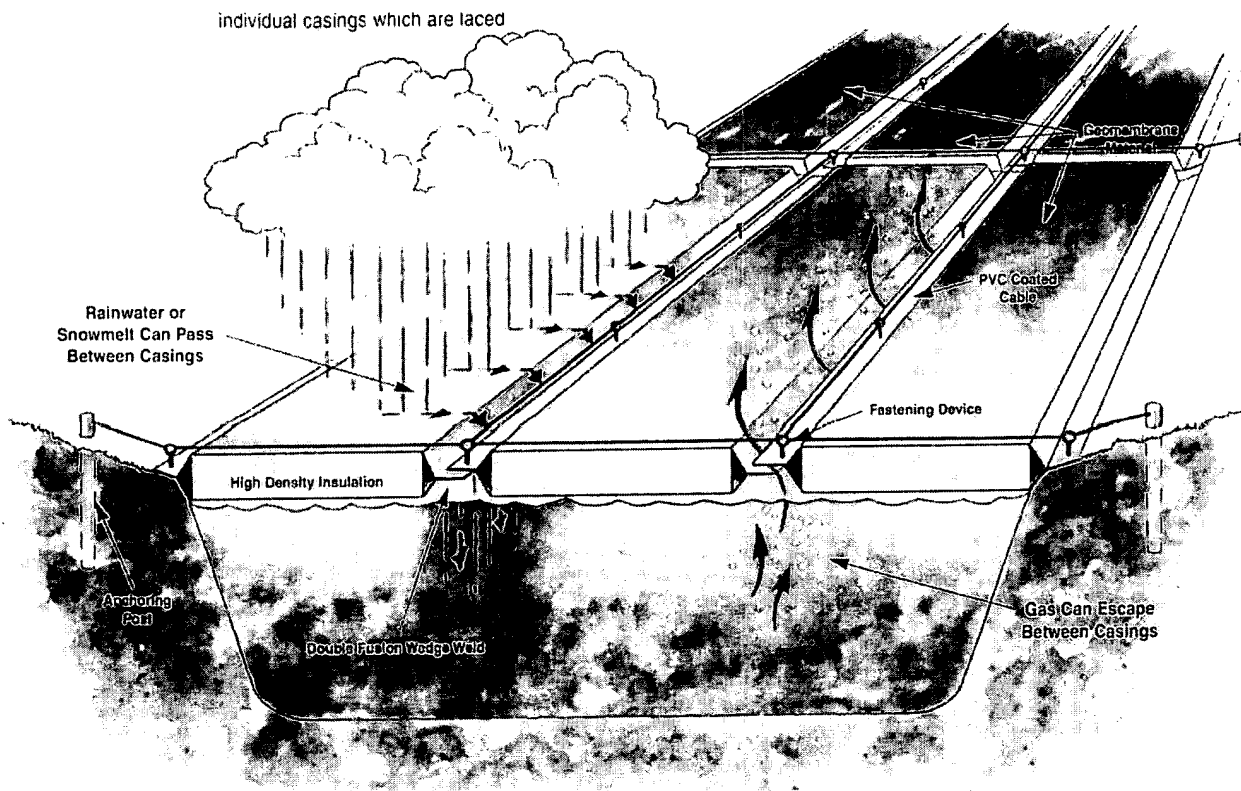
The Office states, “With regard to vent holes, C13 seems to be an enlargement of the circles portion of C4, and C13 shows the vent holes as claimed.” Action at page 3. This is not correct. Reference C13 is an enlarged partial view of element D, which is shown in reference C5. This is explained in the IDS. Reference C13 is not related to reference C4, and Applicants did not make such a statement in the IDS.

The Office also states, “Even if this is not the case, reference C2 shows direct venting, and therefore, it would have been obvious to one of ordinary skill in the art at the time of

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invention to use the teaching of C2 in the teaching of C4 for venting the gases accumulated under the membrane to keep the membrane floating on the surface of the pond.” Action at page 3.

Reference C2 shows and describes gas escaping between the casings:



However, claim 1 recites gas-relief passageways within and extending through a first float compartment membrane or a first membrane and adjacent to a first flotation member, at least one of them being structured such that gas flows **unobstructed through it when the claimed cover system is used**. Neither reference C4 nor C2 discloses or suggests such a gas-relief passageway. Therefore, even in combination, these two references fail to disclose or suggest all the limitations of claim 1, and the obviousness rejection of this claim and its dependents should be withdrawn.

Claim 28 recites the same gas-relief passageways as claim 1. Claim 28 also recites elevating at least a portion of the claimed first membrane so that gas is directly vented to atmosphere through at least of those gas-relief passageways. Neither reference C4 nor C2

discloses or suggests the claimed elevating because gas is not directly vented to atmosphere through such a gas-relief passageway. Therefore, even in combination, these two references fail to disclose or suggest all the limitations of claim 28, and the obviousness rejection of claims 28 and 29 should be withdrawn.

Furthermore, there is no motivation to combine the teachings of the modular cover system of C2 with the cover system shown in C4. As explained in the enclosed declaration of Michael Morgan, the cover system shown in C4 is a partial representation of a cover system similar to those disclosed in U.S. Patent No. 4,503,988 to Gerber (reference A16). Second Morgan Decl. at ¶ 4. The C4 system included a gas collection system for siphoning off gas that was collected under the C4 cover. *Id.* As a result, the C4 system was under negative pressure. *Id.*

If openings were formed in one of the membranes shown in C4, that negative pressure would be jeopardized, potentially rendering the gas collection system less effective or ineffective. *Id.* Thus, there is no motivation to combine the C2 teaching of gas escaping between adjacent panels with the C4 cover system because the asserted combination would render the C4 cover system unsatisfactory for intended purpose. MPEP § 2143.01 at 2100-131 (“If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”).

b. Claim 32

Claim 32 recites, in relevant part, placing a covering system over a body containing some liquid, the covering system comprising a first membrane having an outer edge and a width, and a first flotation member coupled to the first membrane, the first flotation member including a first float having a width that is not more than twenty-five percent of the width of the first membrane.

The method of claim 32 also includes elevating portions of the first membrane above a body containing some liquid and positioning the covering system to allow gas from the body to vent directly to atmosphere **around the outer edge of the first membrane**.

Reference C4 fails to disclose or suggest such positioning. Furthermore, as explained in the enclosed declaration of Michael Morgan, the cover system of C4 was one that was anchored around its perimeter so as to **prevent** the escape of gases around its outer edge. Second Morgan Decl. at ¶ 5. There is, therefore, no motivation to combine the gas-escape teachings of C2 with the C4 cover system. The rejection of claims 32 and 33 should be withdrawn.

5. The Pending Claims Are Patentable over References C5-C13

References C5-C13 are not prior art to the pending claims. As explained in the IDS and in the Declaration of Michael Morgan executed on January 23, 2004, the device shown in references C5-C13 was demonstrated on **October 5, 2000**. This application claims priority to an application filed on **October 5, 2001**. The pending claims are entitled to that October 5, 2001 priority date, as explained in great detail on pages 11-15 of the last response. Thus, the October 5, 2000 demonstration did not occur more than one year prior to the effective filing date of the present claims. 35 U.S.C. ¶ 102(b) (“the invention was . . . in public use . . . in this country, **more than one year** prior to the date of the application”) (emphasis added); *see, e.g., Argus Chem. Corp. v. Fibre Glass-Evercoat Co.*, 759 F.2d 10, 11-12 (Fed. Cir. 1985) (noting that 102(b) on sale date must have occurred “prior to August 7, 1960” for an application with a filing date of August 7, 1961).

The Office states that “an affidavit stating that the actual offer of sale happened not more than one year prior to the effective filing date of the application is required to overcome this

rejection. Attorney's arguments are not sufficient. See 37 C.F.R. § 1.131." This request imposes an improper burden on Applicants.

The inventors of this application can only attest to facts, not an "effective filing date," which concerns a legal issue. Applicants have already attested to the relevant facts through Michael Morgan's January 23, 2004 declaration: the day (October 5, 2000) on which the demonstration (not "offer of sale" as the Office suggests) took place. Furthermore, as explained above, the pending claims are fully supported by the application filed on October 5, 2001.

This is all that is required to establish that the October 5, 2000 demonstration is not prior art to the pending claims. The Examiner and his Supervisor are respectfully requested to consult with a Special Program Examiner about this issue if the Office intends to maintain its position.

C. Claim 1 and Its Dependent Claims Are Novel over Wilson

The Office rejects claims 1, 2, 5, 6, 11-13, 16-18 and 21-23 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,438,863 to Wilson *et al.* (Wilson). Action at page 4. Applicants traverse with respect to the claims that remain pending.

Claim 1 now recites a first plurality of gas-relief passageways positioned either: within the first float compartment membrane and extending between the claimed inside and opposing outside surfaces, or within the first membrane, extending between the claimed top and opposing bottom surfaces, and adjacent to the first flotation member. Wilson fails to teach or suggest such gas-relief passageways. Thus, claim 1 and its rejected dependent claims are novel over Wilson.

D. Claims 28, 29 and 32 Are Patentable over Wilson

The Office rejects claims 28-32 under 35 U.S.C. § 102(b) as being anticipated by or in the alternative, under 35 U.S.C. § 103(a) as being obvious over Wilson. Action at pages 5-6. Applicants traverse with respect to the claims that remain pending.

Claim 28 now recites forming gas-relief passageways either: within the first float compartment membrane and extending between the claimed inside and opposing outside surfaces, or within the first membrane, extending between the claimed top and opposing bottom surfaces, and adjacent to the first flotation member. Wilson fails to teach or suggest such forming. While Wilson does disclose vent openings “along the cover perimeter” (*see* col. 5, lines 29-32 and FIG. 2), those openings are not within and extending through a float compartment membrane, nor are they within and extending through a membrane **and adjacent** to a flotation member. Thus, claims 28 and 29 are novel over Wilson.

Claim 32 recites, in relevant part, placing a covering system over a body containing some liquid, the covering system comprising a first membrane having an outer edge and a width, and a first flotation member coupled to the first membrane, the first flotation member including a first float having a width that is not more than twenty-five percent of the width of the first membrane. The method of claim 32 also includes elevating portions of the first membrane above a body containing some liquid and positioning the covering system to allow gas from the body to vent directly to atmosphere **around the outer edge of the first membrane**.

Wilson fails to disclose or suggest such positioning. The periphery of Wilson’s cover 10 is attached in **fluid-tight relationship** to the upper part of the container 12. Col. 3, lines 21-25; FIG. 2. Gas that collects outside the sump 16 can be vented at openings 66 or using vent pipes 64. Col. 5, lines 26-32. However, there is no disclosure or suggestion in Wilson for allowing gas to escape around the outer edge of cover 10. Accordingly, claim 32 is novel over Wilson.

E. Claims 9, 10, 14, 15 and 32 Are Patentable over Wilson in view of Reference C1

The Office rejects claims 9, 10, 14, 15, 20, 24, 25 and 33 under 35 U.S.C. § 103(a) as being obvious over Wilson in view of reference C1. Action at pages 6-7. Applicants traverse with respect to the claims that remain pending.

Claims 9, 10, 14 and 15 all depend from claim 1. Reference C1 does not cure Wilson's deficiencies. Therefore, claims 9, 10, 14 and 15 are patentable over the asserted combination of Wilson and reference C1.

Claim 33 depends from claim 32. Reference C1 does not cure Wilson's deficiencies (see page "-3-" beneath the heading "3 SCOPE": "Perimeter tie and membrane skirt to 3 feet below the low water level" and page "-4-": "Perimeter of the pond cover shall be complet[e]d with a 4 foot weighted skirt and ropes tied to the concrete wall with a series of eye bolts and gromets at 18 inch intervals.")). Therefore, claim 32 is patentable over the asserted combination of Wilson and reference C1.

F. Claim 34 Has Been Canceled

The Office rejects claim 34 as being unpatentable over Wilson in view of reference C2. Action at pages 7-8. Claim 34 has been canceled because claim 1 is now a duplicate of it. Therefore, Applicants address their arguments to the patentability of claim 1 over Wilson in view of reference C2.

Neither Wilson nor C2 teach or suggest gas-relief passageways positioned within and extending through a first float compartment membrane or a first membrane and adjacent to a first flotation member, at least one of them being structured such that gas flows unobstructed through it when the claimed cover system is used. Thus, even taken in combination, the cited references do not teach or suggest all the limitations of claim 1.

Furthermore, no motivation exists for the asserted combination. Wilson is directed to a cover system for the collection of large volumes of gas. Col. 1, lines 58-62. The flotation strings that are used to prop up the cover 10 and create gas passageways that feed a main gas collection conduit 36 terminate inside the perimeter of the container 12 holding the covered liquid. Col. 4, lines 47-51. This is done so that excess cover material can sink into the liquid to create a sump 16 where rainwater can be collected and siphoned off. Col. 6, lines 49-58. Outside the sump 16, the periphery of the cover 10 is attached in fluid-tight relationship to the upper part of the container 12. Col. 3, lines 21-25; FIG. 2. Gas that collects outside the sump 16 can be vented at openings 66 or using vent pipes 64. Col. 5, lines 26-32. However, all the gas inside the sump is designed to be collected in main gas collection conduit 36 and vented away to “a collection tank, scrubber, burner or other apparatus 56 for treating or disposing of the collected gases.” Col. 5, lines 8-15.

The portion of C2 on which the Office relies does not concern gas collection. It pertains to “insulation, odor containment and/or algae control on ponds and tanks.” *See* second page of C2. As a result, gas is permitted to escape between adjacent casings. Notably, the portion of C2 that concerns gas collection (4th page of C2) specifies the use of a solid top sheet positioned over the modular casings to for “an airtight cap that traps and contains gases.” There is **no mention or suggestion** of allowing gas to escape through the top cover through gas-relief passageways within and extending through that top cover.

Thus, it makes no sense to attempt to combine the teachings of a non-gas collection system with one devoted to gas collection. *See* Second Morgan Decl. at ¶¶ 7-9. Allowing gas to escape from beneath the sump-surrounded portion of Wilson would defeat the purpose of Wilson and render it unsatisfactory for its intended purpose: gas collection. MPEP § 2143.01 at 2100-

131 (“If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”). Furthermore, in a gas-collection cover system like Wilson, it is undesirable to allow rain water to pass through the cover and into the covered liquid because the volume of that “dirty” liquid will increase. Second Morgan Decl. at ¶¶ 7-8. Such increases are avoided. *Id.*

For these reasons, claim 1 and its dependent claims are patentable over the asserted combination of Wilson and C2.

G. Petition for Extension of Time

Pursuant to 37 C.F.R. § 1.136(a), Applicants petition for a two-month extension of time in which to respond to the November 8, 2004 Office Action. If the check for this extension of time has been omitted, or if any fees are due, the Commissioner is authorized to deduct any fees required for any reason relating to the enclosed materials under 37 C.F.R. §§ 1.16 to 1.21 from Fulbright & Jaworski Deposit Account No.: 50-1212/IAEC:006US.


H. Conclusion

The pending claims are in condition for allowance. Should Examiner Menon have any questions concerning this application, the Examiner is invited to contact Applicants’ attorney at (512) 536-3031.

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